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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,167	11/03/2003	David W. Brown	U 0132 OS/CRA	3675
23657	7590	05/14/2007		
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			EXAMINER LANG, AMY T	
			ART UNIT	PAPER NUMBER
			3731	
			MAIL DATE	DELIVERY MODE
			05/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/700,167	Applicant(s) BROWN ET AL.	
	Examiner Amy T. Lang	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

All previous rejections and objections not included in this office action have been withdrawn in light of applicant's amendments filed 11/13/2006.

Response to Arguments

Applicant's arguments filed 11/13/2006 have been fully considered but they are not persuasive.

1. Specifically, applicant argues (A) that Wiggins fails as a reference since there is neither teaching nor suggestion of anti-foam activity.

With respect to argument (A), since Wiggins discloses the same composition as instantly claimed, the lubricating composition would inherently display the same anti-foaming characteristics as instantly claimed.

2. Specifically, applicant argues (B) that Kaylo does not teach an electroplating bath since there is no transfer of metal ions.

With respect to argument (B), attention is drawn to Example I of Kaylo in which Kaylo discloses a coating composition comprising lead. Therefore, the lead ions would be transferred to the electrically conductive substrate so that Kaylo inherently discloses an electroplating bath.

3. Specifically, applicant argues (C) that Larsen teaches that other silicon compounds having different structures are not useful as the antifoaming or foam depressing agents.

With respect to argument (C), Larsen does not teach that no other silicon containing compounds are useful as defoamers, instead Larsen discloses that certain other silicon compounds have been found to function poorly as defoamers. Therefore, Larsen does not teach away from utilizing other defoamers, just the specific defoamers disclosed as poor defoamers.

4. Specifically, applicant argues (D) that the defoamer of Dones is not a lubricating composition.

With respect to argument (D), Dones teaches that the disclosed defoamer is utilized in slurries and fuel (column 3, line 65 through column 4, line 4), which clearly overlap a lubricating composition.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "wherein the base catalyzed reaction product is not epoxy functional." Attention is drawn to formula (II), which represents the base catalyzed reaction product having the formula $R^2X(AO)_nY$, where R^2 is a substituted or unsubstituted organic group. It is the examiner's position that the recitation of "substituted organic group" is so broad that it clearly encompasses, for instance, a hydroxyl group containing organic moiety. Hence, formula (II) clearly encompasses a polyhydric alcohol. It appears that the applicant is arguing that in order for the reaction product to not be epoxy functional, formula (II) must represent a monohydric alcohol (page 15, line 21 through page 16, line 3 of amendment filed 04/12/2006). As explained above that is incorrect. Therefore, this new limitation of epoxy functional groups conflicts with the scope of formula (II) and renders the claim indefinite.

For instance, Kaylo discloses the reaction product of an epihalohydrin, which encompasses epichlorohydrin, and ethylene glycol or polyoxyalkylene, which clearly overlap the instantly claimed formulas (I) and (II) respectively. Therefore, Kaylo also teaches the reaction of compounds (I) and (II). The reaction of Kaylo produces a polyglycidyl, which comprises a free epoxy group. As stated in the amendment filed 11/13/2006, the reaction between the compounds of formulas (I) and (II) could yield unreacted epoxy groups if the reaction was conducted for an insufficient length of time (page 8, lines 4-6). However, the applicant does not clearly define a sufficient length of time and only discloses that the reactions are completed (page 8, lines 13-14). Since Kaylo teaches that the reaction of formulas (I) and (II) are reacted together (column 8, lines 53-55), it would have been obvious to one of ordinary skill at the time of the

invention for the reaction to be completed. Therefore, it is the examiner's position that the instant claim 3 is indefinite since Kaylo provides evidence that reacting formulas (I) and (II) to completion can produce a compound with free epoxy groups.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiggins (US 6,387,962).

For explanation of the rejection, see office action mailed 4/12/2006.

9. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Kaylo (US 6,290,830).

For explanation of the rejection, see office action mailed 4/12/2006.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen (US 2,375,007) in view of Dones (US 6,540,942).

For explanation of the rejection, see office action mailed 4/12/2006.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaylo (US 6,290,830) in view of Dones (6,540,942) and Deresh (US 4,849,059).

For explanation of the rejection, see office action mailed 4/12/2006.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaylo (US 6,290,830) in view of Gross (US 6,532,973) and Deresh (US 4,849,059).

For explanation of the rejection, see office action mailed 4/12/2006.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/1/2007

ATL


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

5/12/07.